

REMARKS/ARGUMENTS

The Examiner allowed claims 1-14.

The Examiner rejected claims 15-41 for failing to comply with the statutory subject matter requirement under 35 U.S.C. §101 (“Section 101”) and under 35 U.S.C. §112, par. 1 (Section 112”). Applicants amended independent system claims 15 and 26 to clarify that a “computer readable storage medium” includes the code and amended article of manufacture claims 28 and 40 to clarify that the article of manufacture comprises a “computer readable storage medium including code that is executed to cause” the claimed operations. The Specification discloses this added requirement in para. [0045], pg. 91 as follows:

The retention policy management system described herein may be implemented as a method, apparatus or article of manufacture using standard programming and/or engineering techniques to produce software, firmware, hardware, or any combination thereof. The term “article of manufacture” as used herein refers to code or logic implemented in hardware logic (e.g., an integrated circuit chip, Programmable Gate Array (PGA), Application Specific Integrated Circuit (ASIC), etc.) or a computer readable medium, such as magnetic storage medium (e.g., hard disk drives, floppy disks,, tape, etc.), optical storage (CD-ROMs, optical disks, etc.), volatile and non-volatile memory devices (e.g., EEPROMs, ROMs, PROMs, RAMs, DRAMs, SRAMs, firmware, programmable logic, etc.). Code in the computer readable medium is accessed and executed by a processor.

Applicants submit for the reasons discussed below that these amendments overcome the Sections 101 and 112 rejections.

1. Applicants Traverse the Objections to the Specification

The Examiner objected to the Specification on Section 101 grounds (35 U.S.C. §101). (Office Action, pgs. 2-3) However, Applicants believe that the Examiner’s objections are misdirected with respect to the Specification. Applicants submit that the amendments to the claims overcome the grounds for the Section 101 rejection.

The Examiner objected to a sentence in the Specification that says the retention policy management system may be implemented as software, firmware or any combination thereof. The Examiner contends that an article of manufacture cannot be defined to be software without a suitable recording medium because this is not permissible claimed subject matter under Section 101. (Office Action, pg. 2)

Applicants traverse this objection because the finding is not applicable to the Specification, but to the claims. Applicants submit that it is entirely technically correct for the Specification to note that the described retention policy management system may be implemented in “software, firmware or any combination thereof.” Notwithstanding, Applicants have amended the claims to clarify that the system and article of manufacture has a “computer readable storage medium” including the code that is executed to perform claimed operations.

The Examiner further objected to the Specification for reciting that a transmission medium “implements” code. (Office Action, pg. 2-4). Applicants traverse this finding. According to the Webster Dictionary, the term “implements” means “to put into practical effect”. Merriam Webster’s Collegiate Dictionary (10th Ed., 1994). Applicants submit that in accordance with this common definition of “implements”, the transmission medium “puts into practical effect” the code when transmitting the code because it is a well known technical fact that code transmitted in a transmission medium is physically encoded in the transmission signal, or put into practical effect through such encoding. This usage of the term “implements” is clear when the full sentence is considered -- “code in which the preferred embodiments are implemented may further be accessible through a transmission medium or from a file server over a network.”

Applicants submit that those skilled in the art would understand that a transmission medium “implementing code” that is accessible through the transmission medium means that the transmission medium, i.e., network transmission line, signals, etc., includes a physical representation (i.e., encoding) or implementation of the program to be transmitted from one location to another.

The Examiner further found that a transmission media is not a tangible media and cited the State Street case to the effect that the claimed invention as a whole must accomplish a practical application and that a transmission media is not a tangible, structure change. (Office Action, pgs. 3-4) Applicants submit that this reasoning is not applicable with respect to the Specification, and that the cited sections of State Street concern the claimed subject matter, not objections to the Specification. The Specification is merely stating the well known technical fact that a program can be implemented or encoded in a “transmission medium, such as a network transmission line, wireless transmission media, signals propagating through space”, etc.

Notwithstanding, Applicants believe the amendments to the claims address the Examiner’s concerns by including the requirement in the “system” and “article of manufacture”

claims that a “computer readable storage medium” includes the code that is executed to perform the claimed operations. Applicants submit that a “computer readable storage medium” including code is a “tangible medium” as the Examiner understands and uses that term.

For all the above reasons, Applicants respectfully submit that the objections to the Specification should be withdrawn.

2. Claims 15-41 Comply with Sections 101 and 112, par. 1

The Examiner rejected claims 15-41 under Section 101 on the grounds that the claimed article of manufacture could cover transmission media, which the Examiner does not believe to be patentable subject matter. (Office Action, pg. 5) Although Applicants disagree and traverse the legal basis for such findings, to expedite prosecution, Applicants have amended the independent system claims 15 and 26 and article of manufacture claims 28 and 40 to clarify that the code is included in a “computer readable storage medium”.

Applicants submit that this amendment overcomes the Section 101 rejection and that such rejection should be withdrawn.

The Examiner also rejected claims 15-41 under 35 U.S.C. §112, par. 1 (Section 112) on the grounds that the “system” and “article of manufacture” as claimed may cover transmission media and that the code in a transmission media “is any code capable of being executed to cause any operations to be performed, since no code is executed while transmitted.” (Office Action, pg. 6) Applicants submit that the amendment to claims 15, 26, 28, and 40 clarifying that a “computer readable storage medium” includes the code overcomes this rejection and that such rejection should be withdrawn.

Conclusion

For all the above reasons, Applicant submits that the pending claims 1-41 are patentable over the art of record. Applicants have not added any claims. Nonetheless, should any additional fees be required, please charge Deposit Account No. 09-0466.

The attorney of record invites the Examiner to contact him at (310) 553-7977 if the Examiner believes such contact would advance the prosecution of the case.

Dated: June 1, 2006

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